UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/751,011</td><td>Applicant(s)
LEON ET AL.</td><td></td></tr>
<tr><td>Examiner
BOB CHUMPITAZ</td><td>Art Unit
3629</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>12 November 2009</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-12 and 14-24* is/are pending in the application.

    4a) Of the above claim(s) *4, 13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-12 and 14-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

This communication is a Non-Final Office Action in response to communication received

on November 12, 2009. Claims 1-3, 5, 10-12, 14, 19-20 have been amended and claims 4 and 13

are cancelled, therefore claims 1-3, 5-12 and 14-24 are pending and addressed below.

Response to Amendments

In light of Applicant's amendments, the Examiner withdraws the previous 35 U.S.C. 112

2nd rejections to claims 5-9, 14-18 and 24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 10 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peterson (US 7,099,350 B2) in view of Wensheng (US 2002/0095456 A1).

As per claims 1, 10 and 19, Peterson discloses a method, computer-readable storage medium,

and system <u>for managing data</u> in a computing system, comprising:

a central processing unit (CPU) (col. 2, lines 34-43: host systems' CPU) ;

a memory, coupled to the CPU (col. 2, lines 34-43: host systems' CPU; col. 3, lines 15-

29: data converted is stored; see also Figs. 1-3, 32-33 and associated text);

extracting, using the computing system, information in a first form,

wherein the first form is associated with a source system, and the information in

the first form comprises employee position data (col. 3, lines 15-29: extracting

data from the first system (source system));

converting, using the computing system, the information in the first form into information

in an intermediate form, wherein the information in the intermediate form is

configured to allow the employee position data to be imported into an employee

position field (col. 3, lines 15-29: extracting data from the first system...then

routing the extracted data from the first system to a first conversion server...at the

first conversion server the data is converted form a format compatible with the

first database structure to an intermediate format);

converting, using the computing system, the information in the intermediate form into

information in a target form, wherein the target form is associated with a target

system, and the information in the target form comprises the employee position

field (col. 3, lines 15-29: extracting data from the first system...then routing the

extracted data from the first system to a first conversion server...at the first

conversion server the data is converted form a format compatible with the first

database structure to an intermediate format...the data in the intermediate format

is then routed to a second conversion server....at the second conversion server, the

data is converted from the intermediate format to a format compatible with the

second database structure...the data converted at the second conversion server is

then stored in the second system (target system)).

Peterson discloses the noted claimed limitations, however with respects to "importing the _employee position data_ into the _employee position field,"_ Peterson does not expressly teach employee position data being imported into an employee position field. However, Peterson discloses the exporting operation wherein the data is pulled and transmitted in data packets (col. 17, lines 17-19; see also Fig. 11). Furthermore, it is well known in the art and would have been obvious to one of ordinary skill in the art at the time of the invention to import/export data (e.g. employee position data) into data fields (e.g. employee position field) in order to transfer data into intended data fields. For example, Wensheng teaches wherein data may be imported into a spreadsheet program such as Excel program of Microsoft Corporation or a database program such as Access in order to utilize the data [0040, 69, 99: employee data]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the method and system for converting and transferring data of Peterson to include importing employee data into data fields as taught by Wensheng in order to pull employee information into the appropriate data fields.

Examiner's note: The Peterson/Wensheng combination discloses the claimed invention as noted above, however does not expressly disclose wherein the information comprises "employee position data." However, the specific type of information, being extracted, converted and imported, is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The providing of data conversion and data transmission steps would be performed the same regardless of what specific type of

information they belong to. Thus this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d

1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d

1031 (Fed. Cir. 1994).

Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Peterson in view of Wensheng and in further view of Mui et al. (US 2003/0229529 A1,

hereinafter Mui).

As per claims 2 and 11, the Peterson/Wensheng combination discloses claims 1 and 10 as

rejected above, but do not expressly disclose using the information in the target form to perform

at least one computer-implemented act from a set of computer-implemented acts comprising:

"creating a new employee position management record in the target system"; and "updating an

existing employee position management record in the target system." However, Mui teaches

wherein learning providers use import and administration tools to create and update catalog and

learning object metadata [0210, 218, 234]. Therefore, it would have been obvious to one of

ordinary skill in the art at the time of the invention to modify the Peterson/Wensheng

combination to include the function for creating and updating information as taught by Mui in

order to create, maintain and update employee information in a particular form so that users can

monitor data (e.g. employee position management record) via business administrative tools.

**Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over
Peterson in view of Wensheng and in further view of Makely et al. (US 6,996,776 B1,
hereinafter Makely) in further view of Mui.**

As per claims 3 and 12, the Peterson/Wensheng combination discloses claims 1 and 10 as
rejected above, but do not expressly disclose extracting, using the computing system,

"information in a third form wherein the third form is associated with a second source
system and the third form is distinct from the source system." However, Peterson
discloses extracting information from a first system and then routing the extracted
information to a conversion server, wherein the information is then converted to be
compatible to an intermediate format, and wherein the converted intermediate formatted
data is then routed to a second conversion server which is stored in a second system
(Abstract). Furthermore, Makely teaches a technique, system, and computer program by
which content created from source files in a first data format and converted to
presentation files in a second data format can be read and used by a subsystem which
reads content in a third data format other than the first and second data formats (col. 3,
lines 4-12; Abstract: extracting information). Therefore, it would have been obvious to
one of ordinary skill in the art at the time of the invention to modify the
Peterson/Wensheng combination to include the process of extracting information in a
third format as taught by Makely in order to make the extracted data available in more
than one type of format so that to make it compatible for data transmission into another
system such as any type of business software system that requires a particular data
format.

Peterson further discloses "converting, using the computing system, the information in

the third form into information in the intermediate form" (col. 3, lines 15-29: extracting

data from the first system...then routing the extracted data from the first system to a first

conversion server...at the first conversion server the data is converted form a format

compatible with the first database structure to an intermediate format); and "converting,

using the computing system, the information in the intermediate form into information in

the target form" (col. 3, lines 15-29: extracting data from the first system...then routing

the extracted data from the first system to a first conversion server...at the first conversion

server the data is converted form a format compatible with the first database structure to

an intermediate format...the data in the intermediate format is then routed to a second

conversion server....at the second conversion server, the data is converted from the

intermediate format to a format compatible with the second database structure...the data

converted at the second conversion server is then stored in the second system (target

system)).

The Peterson/Wensheng/Makely do not expressly disclose using the information in the

target form to perform at least one computer-implemented act from a set of computer-

implemented acts comprising: "creating a new employee position management record in

the target system"; "updating an existing employee position management record in the

target system." However, Mui teaches wherein learning providers use import and

administration tools to create and update catalog and learning object metadata [0210, 218,

234]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Peterson/Wensheng/Makley combination to include the function for creating and updating information as taught by Mui in order to create, maintain and update employee information in a particular form so that users can monitor data (e.g. employee position management record) via business administrative tools.

Claims 5-9, 14-18 and 20-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Wensheng and in further view of Lee et al. (US 2004/0093351 A1, hereinafter Lee).

As per claims 5, 14 and 20, the Peterson/Wensheng combination discloses claims 1, 10 and 19 as rejected above, where Peterson further discloses "the intermediate form…" (col. 3, lines 15-29: intermediate format), but does not expressly disclose:

"…comprises a list of employee positions for defining a hierarchy of data elements"

However, Peterson discloses creating intermediate tables (col. 14, lines 42-64; see also claim 1 and associated text) and employee number fields (col. 30, lines 40-49). In addition, Lee teaches wherein work level is used to record the relative position of each employee in a hierarchy of the organization [0019]. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Peterson/Wensheng combination to include the process of using employee work level information to determine an employee hierarchy within an organization as taught by Lee in order to associate employee position information in relation to the hierarchy of data elements.

Lee further teaches "...comprising: ***one or more elements*** selected from a group

comprising:

> a plurality of employee position elements, wherein the plurality of employee
>
> position elements comprises a related parent position element; **a position**
>
> **identifier**; a position base data element; a position related division element; a
>
> position related organization element; and a position custom data element ([0019]
>
> work level 301).

> **Examiner's note**: with respects to claims 6-9, 15-18 and 21-24 which whom depend
>
> from claims 5, 14 and 20 are rejected on the basis of the Examiners election of "**a**
>
> **position identifier.**"

As per claims 6, 15 and 21, it recites equivalent limitations to claim 5, 14 and 20 and are,

therefore rejected using the same art and rationale as set forth above. In addition, claims 6, 15

and 21 are directed to a non-elected employee position element: "a position base data element."

With respects to claims 7-9, 16-18 and 22-24, "wherein the position related division element

includes a position related division identifier", "wherein the position related organization

element includes a position related organization identifier" and "wherein the related parent

position element includes a related parent position identifier."

> The Examiner notes, as per claims 5, 14 and 20, the examiner elected "**a position**
>
> **identifier."** Claims 7-9, 16-18 and 22-24 are directed to the non-elected employee

position elements: "the position related division element", "the position related

organization element" and "the related parent position element." Accordingly, once the

positively recited steps are satisfied, the method as a whole is satisfied -- regardless of

whether or not other steps are conditionally invocable under certain other hypothetical

scenarios. [See: In re Johnston, 77 USPQ2d 1788 (CA FC 2006); Intel Corp. v. Int'l

Trade Comm'n, 20 USPQ2d 11 61 (Fed. Cir. 1991); MPEP 2106 ll C].

Examiner's note: the specific types of position elements: "the position related division

element", "the position related organization element" and "the related parent position

element" is deemed to be nonfunctional descriptive material and is not functionally

involved in the steps recited. Thus this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d

1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d

1031 (Fed. Cir. 1994).

Please note:

Examiner has pointed out particular references contained in the prior arts of record in the body

of this action for the convenience of the applicant. Although the specified citations are

representative of the teachings in the art and are applied to the specific limitations within the

individual claim, other passages and figures may apply as well. It is respectfully requested

from the applicant, in preparing the response, to consider fully the entire references as

potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

a.   ***"For"***

See *e.g. In re Collier*, 158 USPQ 266, 267 (CCPA 1968)(where the court interpreted the claimed phrase "a connector member for engaging shield means" and held that the shield means was not a positive element of the claim since "[t]here is no positive inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements."

b.   ***"-Able"***

See *e.g. In re Collier*, 158 USPQ 266, 267-68 (CCPA 1968)(where the court interpreted the claimed phrase "said ferrule-forming member being crimpable onto said shield means" and held that the shield means was not a positive element of the claim since "[t]here is no positive inclusion of 'shield means' in what is apparently intended to be a claim to structure consisting of a combination of elements.... "[t]he ferrule or connector member is crimpable but not required, structurally, to be crimped .... These cannot be regarded as structural limitations and therefore not as positive limitations in a claim directed to structure. They cannot therefore be relied on to distinguish from the prior art.")

Applicant(s) are reminded that optional or conditional elements do not narrow the claims

because they can always be omitted. See *e.g.* MPEP §2106 II C: "Language that suggest or

makes optional but does not require steps to be performed or does not limit a claim to a particular

structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]"; and *In*

re Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) "As a matter of linguistic

precision, optional elements do not narrow the claim because they can always be omitted." *In re*

Johnston, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006)(where the Federal Circuit

affirmed the Board's claim construction of "further including that said wall may be smooth,

corrugated, or profiled with increased dimensional proportions as pipe size is increased" since

"this additional content did not narrow the scope of the claim because these limitations are stated

in the permissive form 'may.'").

Response to Argument

Applicant's arguments filed 11/12/2009 have been fully considered. In the remarks the

Applicant(s) argues:

Claims 1, 10 and 19:

(1) Independent Claims 10 and 1 9 recite comparable limitations. Applicants respectfully

submit that none of the cited references, alone or in any combination, teach or suggest, at

the very least: (1) information in a first form comprising employee position data; (2)

information in an intermediate form configured to allow the employee position data to be

imported into an employee position field; (3) information in the target form comprises the

employee position field; and (4) importing the employee position data into the employee

position field. Amended independent Claims 1, 10, and 19 recite new limitations not found within the cited sections of Mui, Kurzius, or Peterson.

The limitations that Kurzius was introduced to purportedly teach have now been removed from Claims 1, 10, and 19. Thus, Applicants respectfully submit that Kurzius is no longer applicable for teaching or suggesting any of the limitations of Claims 1, 10, and 19 (or any of the other claims, for that matter).

No cited section of Mui teaches or suggests that a source system with a data element and a target system with a data field into wiiich the data element is to be imported. Mui simply presents a system with a traditional understanding of exchanging data between two systems: data from a first system is converted and sent to a second system - without any implicit or explicit correlation of any kind between data in the first system format and a data field in the second system format. None of the cited sections of Mui suggest that Mui's Interchange Format is aware or capable of importing data from a first system to a data field in a second system. A straightforward conversion of data as in Mui fails to capture this feature (and others) of the claimed method.

One of skill in the art would have no basis for extrapolating from whatever teachings Mui might be said to provide, in an attempt to show, teach or suggest the claimed invention, at least because Mui is silent regarding any concepts remotely comparable to a first form with employee position data as claimed, an intermediate form that allows for the importing of data as claimed, a target form with an employee position field as claimed, and the importing of data from the employee position data into the employee position field, as claimed. In other words, without any suggestion of a link between the data on

one system to a data field on a second system, an ordinary artisan would have no basis for adding such an incongruous feature to Mui's conversions.

Also similar to Mui, Peterson's concept of conversion is in line with the traditional understanding of conversions: taking data compatible with a first system and changing that data to be compatible with a second system. Such a traditional understanding of a conversion of data fails to teach or suggest the claimed combination of employee position data in a source form, an employee position field in a target form, and the importing of the employee position data into the employee position field via an intermediate form configured to allow such an importing of data.

Thus, similar to Mui, there is no reason that an ordinary artisan would have for attempting to extend Peterson in any regard, at least given Peterson's silence regarding the new limitations. It would be unreasonable to expect a particular outcome from an ordinary artisan when the artisan is given such a blank slate.

For at least these reasons, Applicants submit that neither Mui nor Pederson nor Kurzius, taken alone or in combination, provide disclosure of the limitations of independent Claims 1, 10, 19, and all dependent claims. Applicants therefore respectfully request the Examiner's reconsideration and withdrawal of the rejections to these claims and an indication of the allowability of same.

In response to argument (1), based on new grounds of rejections the argument is now moot. See rejection above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BOB CHUMPITAZ whose telephone number is (571)270-5494. The examiner can normally be reached on M-TR: 7:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN WEISS can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-270-6494.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. C.
Examiner, Art Unit 3629

/JOHN G. WEISS/
Supervisory Patent Examiner, Art Unit 3629